

R E M A R K S

Claims 1 to 12 and 14 to 20 as set forth in Appendix II of this paper are now pending in this case. Claim 13 has been canceled, Claims 1, 2 and 8 to 11 have been amended, and Claims 14 to 20 have been added as indicated in Appendix I of this paper.

Applicants have canceled Claim 13 in view of the Examiner's rejection under Sections 101 and 112, ¶2. Withdrawal of the respective rejections is therefore solicited.

In light of the Examiner's additional rejections under Section 112, ¶2, applicants have

- (1) amended Claim 1 to remove the comma between "alkoxyalkoxy" and "group", and to revise the last line to refer to a "salt" or "N-oxide" in the alternative¹⁾; and
- (2) amended Claims 10 and 11 to remove the expression "general" preceding "formula III" and "formula I", respectively²⁾.

Withdrawal of the rejection of Claims 1 to 8 and 10 to 12 under Section 112, ¶2, is therefore solicited.

Additionally, applicants have effected a number of changes in the language of Claims 1, 2, 8, 9, 10 and 11. In Claim 1, the definition of Z as a single bond has been deleted; Claim 2 has been amended accordingly. Claim 2 has further been amended by deleting the denotation "0" in the definition of m. Claim 8 has been amended correspondingly. The latter change renders the proviso in Claim 2 redundant and the proviso has therefore been canceled. Claim 8 has been amended to depend upon Claim 2. Additionally, the reference "X, R¹ and R⁸ have the meaning given in any of the preceding claims" has been canceled, the denotation of W-V as "N-NR⁷" has been replaced by --N-NR⁹-- in light of formula (1) set forth in Claim 7, and the definitions of R⁸ and R⁹ which are provided in Claim 7 have been introduced into Claim 8. Claim 9 has been revised to be independent, and the name of the 9th compound has been corrected on the basis of applicants' disclosure on page 8, indicated lines 11 and 12, of the application. Withdrawal of the Examiner's objection to Claim 9 is therefore solicited. In Claim 10, applicants have replaced "Claim 2" by --claim 2--, and have re-

1) Re items (1.) and (2.) of the rejection; the last line of Claim 2 has been amended accordingly.

2) Re item (3.) of the rejection.

moved the redundant expressions "(a)", "R¹, A, X, Z and m have the meaning given and" and "R³ has the meaning given". The dependency of Claim 11 has been changed from "as claimed in claim 1," to --according to claim 2--.

New Claim 14 relates to herbicidal compositions comprising at least one of the compounds enumerated in Claim 9 and is supported by applicants' original Claim 9 in conjunction with Claim 11. New Claims 15 to 20 correspond to Claims 2 and 4 to 8, with the difference that

- (a) R³ of formula (I) differs from a hydrogen atom; and
- (b) the definition of m includes the denotation "0".

No new matter has been added.

The Examiner has rejected Claims 1, 2, 3, 6, 7 and 10 to 13 under Section 102(b) as being anticipated by the teaching of *Nebel et al.* (WO 98/21199)³).

The teaching of *Nebel et al.* relates to pyridines and their N-oxides which carry a pyrazolyl moiety bonded directly to the ring carbon atom adjacent to the pyridine nitrogen. Applicants' formula (I) as defined in Claims 1 and 2 requires that any 5-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Claims 1 and 2 are therefore clearly distinguished from the teaching of *Nebel et al.* The same applies to Claims 3, 6, 7 and 10 to 12 which incorporate the same requirement by reference to Claim 2. Claim 13 has been canceled. Favorable reconsideration of the Examiner's position and withdrawal of the rejection under Section 102(b) based on the disclosure of *Nebel et al.* is therefore respectfully solicited.

Applicants' new Claims 15 to 20 also require that any 5-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Those new claims are, therefore, equally not anticipated by the teaching of *Nebel et al.*

The Examiner has rejected Claims 2, 3, 6 and 10 to 13 under Section 102(b) as being anticipated by the teaching of *Young et al.* (EP 318 083)⁴).

3) Re items (1.) and (3.) of the "Claim Rejections - 35 U.S.C. §102" section of the Office action.

4) Re item (2.) of the "Claim Rejections - 35 U.S.C. §102" section of the Office action.

The teaching of *Young et al.* relates to pharmaceutically active compounds which generically embrace applicants' compounds of formula (I). However, the test for anticipation is one of identity, the identical invention must be shown in as complete detail as is contained in the claim⁵). In fact, the Federal Circuit has stated that it is error to treat claims as a catalog of separate parts, in disregard of the part-to-part relationships set forth in the claims that give those claims their meaning⁶). The generic teaching of *Young et al.* fails to in detail compounds wherein the ring nitrogen atom is linked to ring carbon atoms which carry

- (a) an acetylene moiety corresponding to the group $-C\equiv C-R^3$ of applicants' formula (I), and
- (b) a moiety corresponding to the group $-Z-A$ of applicants' formula (I).

Young et al.'s teaching therefore fails to anticipate the particularities of applicants' compounds of formula (I) as defined in Claim 2. The same applies to Claims 3, 6 and 10 to 12 which incorporate the requirements of Claim 2 by reference. Claim 13 has been canceled. Favorable reconsideration of the Examiner's position and withdrawal of the rejection under Section 102(b) based on the disclosure of *Young et al.* is therefore respectfully solicited.

Further, it is respectfully submitted that the mere fact that claimed compounds may be encompassed by a disclosed generic formula does not by itself render the claimed compounds obvious⁷). The disclosure of *Young et al.* relates to pharmaceutical compounds. The disclosure therefore provides nothing which would suggest to a person of ordinary skill that a selection of the particular radicals which characterize applicants' compounds, and a combination of those radicals in the manner necessary to arrive at applicants' formula (I), would result in compounds which exhibit herbicidal activity. It is well settled that the invention as a whole referenced in Section 103(a) includes not only the subject matter as recited in the claims, but also the properties and results of such subject matter which are

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- 5) ie. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (CAFC 1989)
 - 6) ie. Lindemann Maschinenfabrik v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (CAFC 1984)
 - 7) ie. In re Baird, 16 F.3d 380, 29 USPQ2d 1550 (CAFC 1994); see also Corning Glass Works v. Sumitomo Electric U.S.A., 868 F.2d 1251, 9 USPQ2d 1962 (CAFC 1989), which holds that a genus does not inherently disclose all species; and In re Jones, 958 F.3d 347, 21 USPQ2d 1614 (CAFC 1992), which holds that a genus does not render all species that happen to fall within the genus obvious.

disclosed in the specification⁸). The disclosure of *Young et al.* therefore also fails to render applicants' compounds of formula (I) obvious within the meaning of Section 103(a).

The foregoing remarks are equally applicable where the subject matter of Claims 15 to 20 is concerned, and the compounds defined in those claims are therefore neither anticipated under Section 102(b), or rendered obvious under Section 103(a), by the teaching of *Young et al.* Favorable action is solicited.

The Examiner has rejected Claims 2, 3 and 6 under Section 102(b) as being anticipated by the teaching of *Sekiguchi et al.* (Chem. Abstr. 115:256727)⁹).

In accordance with applicants' formula (I) defined in Claim 2 it is required that the pyridyl ring carries, in addition to the acetylene group $-C\equiv C-R^3$ and the group $-Z-A$, at least one further radical R^1 . Applicants' compounds of formula (I) as defined in Claim 2 are therefore clearly distinguished from the teaching of *Sekiguchi et al.* The same applies to Claims 3 and 6 which incorporate the requirements of Claim 2 by reference. Favorable reconsideration of the Examiner's position and withdrawal of the rejection under Section 102(b) based on the disclosure of *Sekiguchi et al.* is therefore respectfully solicited.

The compounds of formula (I) defined in new Claims 15 to 20 are distinguished from the disclosure of *Sekigushi et al.* in the requirement that the radical R^3 of the acetylene group $-C\equiv C-R^3$ is a radical different from hydrogen. The subject matter of Claims 15 to 20 is, therefore, equally not anticipated by the teaching of *Sekigushi et al.* Favorable action is solicited.

The Examiner has rejected Claims 1, 2, 4, 5 and 10 to 13 under Section 102(b) as being anticipated by the teaching of *Robson et al.* (WO 92/08714)¹⁰).

The teaching of *Robson et al.* relates to pyridines which carry a pyrimidine moiety bonded directly to the ring carbon atom adjacent to the pyridine nitrogen. Applicants' formula (I) as defined in Claims 1 and 2 requires that any 6-membered heteroaromatic group which is

8) ie. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)

9) Re item (4.) of the "Claim Rejections - 35 U.S.C. §102" section of the Office action.

10) Re item (5.) of the "Claim Rejections - 35 U.S.C. §102" section of the Office action.

linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Claims 1 and 2 are therefore clearly distinguished from the teaching of **Robson et al.** The same applies to Claims 4, 5 and 10 to 12 which incorporate the same requirement by reference to Claim 2. Claim 13 has been canceled. Favorable reconsideration of the Examiner's position and withdrawal of the rejection under Section 102(b) based on the disclosure of **Robson et al.** is therefore respectfully solicited.

Applicants' new Claims 15 to 20 also require that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Those new claims are, therefore, equally not anticipated by the teaching of **Robson et al.**

The Examiner has rejected Claims 2 and 6 under Section 102(b) as being anticipated by the teaching of **Ziessel et al.** (Chem. Abstr. 134:193375)¹¹).

The teaching of **Ziessel et al.** provides pyridines which carry a pyridine moiety bonded directly to the ring carbon atom adjacent to the pyridine nitrogen. Applicants' formula (I) as defined in Claim 2 requires that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Claim 2 is therefore clearly distinguished from the teaching of **Ziessel et al.** The same applies to Claim 6 which incorporates the same requirement by reference to Claim 2. Favorable reconsideration of the Examiner's position and withdrawal of the rejection under Section 102(b) based on the disclosure of **Ziessel et al.** is therefore respectfully solicited.

Applicants' new Claims 15 to 20 also require that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Those new claims are, therefore, equally not anticipated by the teaching of **Ziessel et al.**

The Examiner has rejected Claims 2 and 6 under Section 102(b) as being anticipated by the teaching of **Romero et al.** (Chem. Abstr.

11) Re item (6.) of the "Claim Rejections - 35 U.S.C. §102" section of the Office action.

130:296640)¹²).

The teaching of *Romero et al.* provides pyridines which carry a 5- or 6-membered heterocyclic moiety bonded directly to the ring carbon atom adjacent to the pyridine nitrogen. Applicants' formula (I) as defined in Claim 2 requires that any 5- or 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Claim 2 is therefore clearly distinguished from the teaching of *Romero et al.* The same applies to Claim 6 which incorporates the same requirement by reference to Claim 2. Favorable reconsideration of the Examiner's position and withdrawal of the rejection under Section 102(b) based on the disclosure of *Romero et al.* is therefore respectfully solicited.

Applicants' new Claims 15 to 20 also require that any 5- or 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Those new claims are, therefore, equally not anticipated by the teaching of *Romero et al.*

The Examiner has rejected Claim 2 under Section 102(b) as being anticipated by the teaching of *Nakayama et al.* (Chem. Abstr. 129:189329)¹³).

The teaching of *Nakayama et al.* provides pyridines which carry a tetrazol moiety bonded directly to the ring carbon atom adjacent to the pyridine nitrogen. Applicants' formula (I) as defined in Claim 2 requires that any 5-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Claim 2 is therefore clearly distinguished from the teaching of *Nakayama et al.* Favorable reconsideration of the Examiner's position and withdrawal of the rejection under Section 102(b) based on the disclosure of *Nakayama et al.* is therefore respectfully solicited.

Applicants' new Claims 15 to 20 also require that any 5-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Those new claims are, therefore, equally not

12) Re item (7.) of the "Claim Rejections - 35 U.S.C. §102" section of the Office action.

13) Re item (8.) of the "Claim Rejections - 35 U.S.C. §102" section of the Office action.

anticipated by the teaching of *Nakayama et al.*

The Examiner has rejected Claims 2 and 6 under Section 102(b) as being anticipated by the teaching of *Nitschke et al.* (Chem. Abstr. 128:321535)¹⁴).

The teaching of *Nitschke et al.* provides pyridines which carry a pyridine moiety bonded directly to the ring carbon atom adjacent to the pyridine nitrogen. Applicants' formula (I) as defined in Claim 2 requires that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Claim 2 is therefore clearly distinguished from the teaching of *Nitschke et al.* The same applies to Claim 6 which incorporates the same requirement by reference to Claim 2. Favorable reconsideration of the Examiner's position and withdrawal of the rejection under Section 102(b) based on the disclosure of *Nitschke et al.* is therefore respectfully solicited.

Applicants' new Claims 15 to 20 also require that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Those new claims are, therefore, equally not anticipated by the teaching of *Nitschke et al.*

The Examiner has rejected Claims 2 and 6 under Section 102(b) as being anticipated by the teaching of *Chamchoumis et al.* (Chem. Abstr. 131:82037)¹⁵).

The teaching of *Chamchoumis et al.* provides pyridines which carry a pyridine moiety bonded directly to the ring carbon atom adjacent to the pyridine nitrogen. Applicants' formula (I) as defined in Claim 2 requires that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Claim 2 is therefore clearly distinguished from the teaching of *Chamchoumis et al.* The same applies to Claim 6 which incorporates the same requirement by reference to Claim 2. Favorable reconsideration of the Examiner's position and withdrawal of the rejection under Section 102(b) based on the disclosure of *Chamchoumis et al.* is therefore respectfully

14) Re item (9.) of the "Claim Rejections - 35 U.S.C. §102" section of the Office action.

15) Re item (10.) of the "Claim Rejections - 35 U.S.C. §102" section of the Office action.

solicited.

Applicants' new Claims 15 to 20 also require that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Those new claims are, therefore, equally not anticipated by the teaching of *Chamchoumis et al.*

The Examiner has rejected Claims 2 and 6 under Section 102(b) as being anticipated by the teaching of *Houghton et al.* (Chem. Abstr. 127:256664)¹⁶⁾.

The teaching of *Houghton et al.* provides pyridines which carry a pyridine moiety bonded directly to the ring carbon atom adjacent to the pyridine nitrogen. Applicants' formula (I) as defined in Claim 2 requires that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Claim 2 is therefore clearly distinguished from the teaching of *Houghton et al.* The same applies to Claim 6 which incorporates the same requirement by reference to Claim 2. Favorable reconsideration of the Examiner's position and withdrawal of the rejection under Section 102(b) based on the disclosure of *Houghton et al.* is therefore respectfully solicited.

Applicants' new Claims 15 to 20 also require that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Those new claims are, therefore, equally not anticipated by the teaching of *Houghton et al.*

The Examiner has rejected Claims 2 and 6 under Section 102(b) as being anticipated by the teaching of *Ziessel et al.* (Chem. Abstr. 125:221516)¹⁷⁾.

The teaching of *Ziessel et al.* provides pyridines which carry a pyridine moiety bonded directly to the ring carbon atom adjacent to the pyridine nitrogen. Applicants' formula (I) as defined in Claim 2 requires that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Claim 2 is there-

16) Re item (11.) of the "Claim Rejections - 35 U.S.C. §102" section of the Office action.

17) Re item (12.) of the "Claim Rejections - 35 U.S.C. §102" section of the Office action.

fore clearly distinguished from the teaching of *Ziessel et al.* The same applies to Claim 6 which incorporates the same requirement by reference to Claim 2. Favorable reconsideration of the Examiner's position and withdrawal of the rejection under Section 102(b) based on the disclosure of *Ziessel et al.* is therefore respectfully solicited.

Applicants' new Claims 15 to 20 also require that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Those new claims are, therefore, equally not anticipated by the teaching of *Ziessel et al.*

The Examiner has rejected Claims 2 and 6 under Section 102(b) as being anticipated by the teaching of *Inouye et al.* (Chem. Abstr. 124:146602)¹⁸⁾.

The teaching of *Inouye et al.* provides pyridines which carry a pyridine moiety bonded directly to the ring carbon atom adjacent to the pyridine nitrogen. Applicants' formula (I) as defined in Claim 2 requires that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Claim 2 is therefore clearly distinguished from the teaching of *Inouye et al.* The same applies to Claim 6 which incorporates the same requirement by reference to Claim 2. Favorable reconsideration of the Examiner's position and withdrawal of the rejection under Section 102(b) based on the disclosure of *Inouye et al.* is therefore respectfully solicited.

Applicants' new Claims 15 to 20 also require that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Those new claims are, therefore, equally not anticipated by the teaching of *Inouye et al.*

The Examiner has rejected Claims 2 and 6 under Section 102(b) as being anticipated by the teaching of *Koevari et al.* (Chem. Abstr. 123:198925)¹⁹⁾.

18) Re item (13.) of the "Claim Rejections - 35 U.S.C. §102" section of the Office action.

19) Re item (14.) of the "Claim Rejections - 35 U.S.C. §102" section of the Office action.

The teaching of *Koevari et al.* provides pyridines which carry a pyridine moiety bonded directly to the ring carbon atom adjacent to the pyridine nitrogen. Applicants' formula (I) as defined in Claim 2 requires that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Claim 2 is therefore clearly distinguished from the teaching of *Koevari et al.* The same applies to Claim 6 which incorporates the same requirement by reference to Claim 2. Favorable reconsideration of the Examiner's position and withdrawal of the rejection under Section 102(b) based on the disclosure of *Koevari et al.* is therefore respectfully solicited.

Applicants' new Claims 15 to 20 also require that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Those new claims are, therefore, equally not anticipated by the teaching of *Koevari et al.*

The Examiner has rejected Claims 2 and 6 under Section 102(b) as being anticipated by the teaching of *Potts et al.* (Chem. Abstr. 118:233840)²⁰).

The teaching of *Potts et al.* provides pyridines which carry a pyridine moiety bonded directly to the ring carbon atom adjacent to the pyridine nitrogen. Applicants' formula (I) as defined in Claim 2 requires that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Claim 2 is therefore clearly distinguished from the teaching of *Potts et al.* The same applies to Claim 6 which incorporates the same requirement by reference to Claim 2. Favorable reconsideration of the Examiner's position and withdrawal of the rejection under Section 102(b) based on the disclosure of *Potts et al.* is therefore respectfully solicited.

Applicants' new Claims 15 to 20 also require that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Those new claims are, therefore, equally not anticipated by the teaching of *Potts et al.*

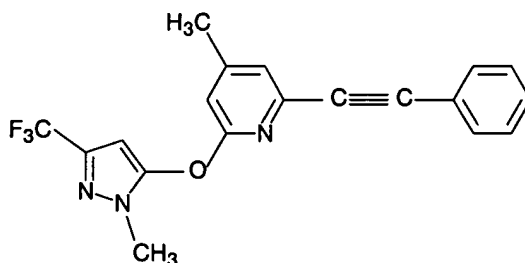
20) Re item (15.) of the "Claim Rejections - 35 U.S.C. §102" section of the Office action.

The Examiner has rejected Claims 2 and 6 under Section 102(b) as being anticipated by the teaching of *Butler et al.* (Chem. Abstr. 115:207819)²¹).

The teaching of *Butler et al.* provides pyridines which carry a pyridine moiety bonded directly to the ring carbon atom adjacent to the pyridine nitrogen. Applicants' formula (I) as defined in Claim 2 requires that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Claim 2 is therefore clearly distinguished from the teaching of *Butler et al.* The same applies to Claim 6 which incorporates the same requirement by reference to Claim 2. Favorable reconsideration of the Examiner's position and withdrawal of the rejection under Section 102(b) based on the disclosure of *Butler et al.* is therefore respectfully solicited.

Applicants' new Claims 15 to 20 also require that any 6-membered heteroaromatic group which is linked to the ring carbon atom adjacent to the pyridine nitrogen is connected through a moiety "Z" (ie. an oxygen or sulfur atom). Those new claims are, therefore, equally not anticipated by the teaching of *Butler et al.*

In view of the Examiner's request for an election of species, applicants herewith elect the compound 2-(1-methyl-3-trifluoromethyl-pyrazol-5-yloxy)-4-methyl-6-(2-phenylethynyl)-pyridine which is represented by the following formula:



The compound is named as the first compound in Claim 9, and the claims relate to the compound as follows:

Claim 1 relates to a method of controlling undesired plants with the elected compound;

Claims 2 to 4, 6 to 9, 15, 16 and 18 to 20 are generic to the elected

21) Re item (16.) of the "Claim Rejections - 35 U.S.C. §102" section of the Office action.

compound;

Claim 10 relates to a process for the preparation of the elected compound; and

Claims 11, 12 and 14 relate to a composition comprising the elected compound.

The Examiner has rejected Claims 2, 6, 7, 8 and 10 under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of *Katsuda et al.* (JP 59/152303; in the following also referenced as *Katsuda*^a) or *Katsuda et al.* (JP 59/157004; in the following also referenced as *Katsuda*^b)²²).

As acknowledged by the Examiner, applicants' compounds of formula (I) as defined in Claim 2 differ from the compounds disclosed in the Japanese references in the positions of the (het)aryloxy group relative to the pyridine ring. In accordance with the teachings of *Katsuda*, the substituents are bonded to the 2- and the 5-position of the pyrimidine ring whereas applicants' formula (I) of Claim 2 requires a 2,6-substitution.

Additionally, applicants' formula (I) of Claim 2 requires the presence of at least one additional radical R¹ as substituent of the pyridyl ring, whereas the pyridyl ring of the compounds disclosed in the Japanese references carry only the acetylene moiety and the (het)aryloxy group as substituents of the pyridyl ring. Furthermore, applicants' compounds exhibit herbicidal properties whereas the compounds taught by *Katsuda et al.* are insecticides and acaricides.

In order for a person of ordinary skill in the art to arrive at applicants' compounds based on the teaching disclosed in the Japanese references it would therefore be necessary to modify *Katsuda et al.*'s compounds by

- (a) altering the relative position of the (het)aryloxy group to arrive at the 2,6-substitution of applicants' compounds, and
- (b) introducing at least one further substituent into the pyridyl ring to arrive at a group corresponding to applicants' radicals R¹_m.

While the generic disclosure of *Katsuda et al.* allows for any relative positioning of an acetylene substituent and the (het)aryloxy moiety, nothing suggests or implies the introduction of an additional

22) "Claim Rejections - 35 U.S.C. §103" section of the Office action.

radical in accordance with modification (b). Additionally, there is nothing in the teachings of *Katsuda et al.* which suggests or implies that structural changes as necessary to arrive at applicants' compounds (I) of Claim 2 would also impart herbicidal properties. When taken as a whole, the subject matter defined in applicants' Claim 2 therefore cannot be taken as being rendered obvious by the teachings of *Katsuda et al.* within the meaning of Section 103(a)²³). Favorable reconsideration of the Examiner's position and withdrawal of the rejection under Section 103(a) based on the teachings of *Katsuda et al.* is therefore respectfully solicited.

The compounds of formula (I) which are defined in applicants' new Claims 15 to 20 allow for the absence of a substituent R¹. Those compounds are, however, further distinguished from the disclosure of *Katsuda et al.* in the requirement that the radical R³ of the acetylene group $-C\equiv C-R^3$ is a radical different from hydrogen. The foregoing remarks therefore equally apply where the subject matter of Claims 15 to 20 is concerned, and the invention defined in Claims 15 to 20 is, therefore, equally not rendered obvious within the meaning of Section 103(a) by the teachings of *Katsuda et al.* Favorable action is solicited.

The Examiner has reiterated the requirement to restrict the claims with regard to the meaning of X to either one of the meanings "N" or "CR²". Reconsideration of the Examiner's requirement is respectfully solicited in light of the attached amendment which significantly reduces the scope of the claims, and the burden on the Examiner, in view of the limitation of Z. Favorable action is respectfully solicited.


In light of the foregoing and the attached, the subject matter defined in applicants' claims is deemed to be patentable under the pertinent provisions. Allowance of the application should therefore be equitable.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit

23) For example, *In re Antonie*, footnote 8, which holds that the invention as a whole referenced in Section 103(a) includes not only the subject matter recited in the claim but also the properties and results which are disclosed in the application.

Account No. 11.0345. Please credit any excess fees to such deposit account.

Respectfully submitted,
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Encl.: THE LISTING OF CLAIMS (Appendix I)
THE AMENDED CLAIMS (Appendix II)

HBK/BAS